



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address : COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY
07/802,045	01/17/92	STRACNE	

EXAMINER

BUGATSKY, G

ART UNIT PAPER NUMBER

CUSHMAN, DABBY & CUSHMAN
1615 L STREET, NW
ELEVENTH FLOOR
WASHINGTON, DC 20036-5601

1814
DATE MAILED:

8

This action has been examined in the name of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

06/10/92

for restriction only

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.
A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☐ Claims _____ are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1, 2, 7, 8, 10, and 13-15, drawn to DNA encoding autotaxin and recombinant methods of its production, classified
5 in Class 435, subclass 69.1.

II. Claims 3-6, 11, 12, and 16-17, drawn to autotaxin and peptides thereof, classified in Class 530, subclass 350.

III. Claim 9, drawn to antibodies specific for autotaxin, classified in Class 530, subclass 387.

10 The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can
15 be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the protein can be synthesized by chemical means.

The inventions of groups II and III are independent,
20 mutually exclusive and patentably distinct products and each can be independently synthesized by chemical means. The searches are not co-extensive, and it would therefore place undue burden on the examiner to examine several independent inventions in one application.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter and the search for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Kathy Cassin on 3 June, 1992 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that in order for the response to this requirement to be complete, it must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

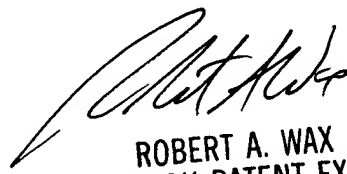
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriele E. Bugaisky, Ph.D. whose telephone number is (703) 308-4201.

Serial No. 07/822043
Art Unit 1814

-4-

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the
5 Official Gazette, 1096 OG 30 (November 15, 1989). The CM-1 Fax Center number is (703) 308-4227.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


ROBERT A. WAX
SUPERVISORY PATENT EXAMINER
GROUP 180

geb

10 geb
June 5, 1992